

Serial No. 10/828,634

AMENDMENTS TO THE DRAWINGS

The attached formal drawings include changes to Figures 1 and 3, both on sheet 1. Reference no. "66" has been changed to "64" and/or has been deleted from Figures 1 and 3. The replacement drawings sheets 1-7 are formal drawings intended to replace originally-filed sheets 1-7.

Attachment: Replacement sheets 1-7

REMARKS

Claims 1-13, 16-30, and 32-37 are pending. Claims 1-7 and 9-33 are rejected. Claim 15 is rejected under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Claims 1, 17-19, 25, 27, 28, and 30 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. US2002/0179307 to Schmidt, et al. (hereinafter "Schmidt"). Claims 3-7, 9, 10, 14-16, 24, and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt. Claims 2 and 20-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt in view of U.S. Patent No. 5,253,716 to Mitchell (hereinafter "Mitchell"). Claims 11-13, 26, and 31-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt in view of U.S. Patent No. 5,301,756 to Relyea, et al. (hereinafter "Relyea"). Claims 1-7, 9, 10, 14-25, and 27-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell in view of U.S. Patent No. 2,548,621 to Rutledge (hereinafter "Rutledge"). By this amendment, claims 1, 6, 25, and 32 are amended. Claims 14, 15, and 31 are canceled. New claims 34-37 are added. No new matter is added. Reconsideration and allowance is requested.

Claim 1 is amended to recite that the second member is shorter than the first member, such that the shape of the apparatus is more similar to that of an axe rather than that of a bayonet. The cited references each disclose a bayonet-style apparatus in which the second member (the member having "a plurality of holes") is longer than the first member (the member comprising "a hose connector").

In Schmidt, only the alternative embodiment of Figures 10 and 11 includes first and second members; in that embodiment the second member is shown to be substantially longer than the first member. The only purpose of the first member seems to be to allow attachment of a hose to "the side of the tube" 1 (the second member) rather than to the end of the tube 1 as shown in the other embodiments. Nothing in Schmidt teaches or suggests that the first member could be made longer than the second member. Indeed, use of a longer, rigid first member would undermine the function of Schmidt, which exerts a force along the longitudinal axis of the second member using the weight 4.

Likewise with Mitchell, the first member (the input port 40) is shown to be substantially shorter than the second member (tubular members 22, 24, 26). Nothing in Mitchell teaches or suggests that the first member could be extended to be longer than the

second member. As with Schmidt, the Mitchell device is adapted for use as a bayonet-style device, rather than as an axe-style device of the present invention. Extension of the first member of Mitchell (the input port 40) to be longer than the second member would make the Mitchell device unwieldy as a bayonet-style device and would thereby undermine the functionality of the Mitchell device.

As amended, claim 1 is allowable. Claims 2-5, 9-13, 16-24, and 36-37 depend from claim 1 and for this reason and the other limitations they recite, are also allowable. Reconsideration is requested.

Claim 6

Claim 6 has been rewritten in independent form including the limitations of the claim from which it depends (original claim 1).

The rejection of claim 6 is respectfully traversed. Claim 6 is rejected under section 103(a) as being obvious in view of Schmidt and is also rejected under section 103(a) as being unpatentable over Mitchell in view of Relyea. To establish prima facie obviousness under section 103, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2143. None of the cited references teach or suggest the use of a hand guard “connected to the first member,” as recited in claim 6. Although use of a hand guard may be known in the art, all of the cited references are bayonet-style devices that are designed to be held by what the Office Action characterizes as their “second members” and not by their “first member” as recited in claim 6. The Office Action asserts that Schmidt discloses an apparatus with first and second members in Figures 10 and 11.

As recited in independent claim 1 (from which claim 6 depends) the “first member” includes a “second end comprising a hose connector.” The hand guard recited in claim 6 is connected to the “first member” – that is, the member having a “hose connector.” The corresponding “first member” of Schmidt is the short, unnumbered, threaded portion on the lower left sides of Figures 10 and 11.

The “second member” recited in independent claim 1 (from which claim 6 depends) includes the “plurality of holes.” The elongated nozzle tube 1 of Schmidt includes holes and thus corresponds to the “second member” recited in claim 1.

Schmidt does not teach or suggest operating its apparatus by holding onto the first member. To the contrary, Schmidt teaches against holding the first member during use because Schmidt is specifically designed to be held by the second member (the “nozzle tube” 1), rather than the first member. The second member of Schmidt provides a sliding weight 4 with handles 5 that are to be held by the user. “The operator grasps the weight handles 5 with his hands and moves the sliding weight 4 back and fourth [sic] in a reciprocating motion so that the sliding weight 4 impacts the weight stop 3 with a substantial force, thus driving the nozzle tube 1 and pointed head 2 farther into the wall.” (Schmidt, para. 0043.) To properly operate the Schmidt apparatus, the user’s hands must be placed on the second member and not the first member. The first member of Schmidt disclosed in the alternative embodiment of Figures 10 and 11 appears to exist merely as an alternative means of directing fluid into the nozzle tube 1, because the first member is shown to be substantially shorter than the second member and is not designed to be held by the user.

Further, the rejection of claim 6 is improper because the purpose of Schmidt would be defeated if the user held the first member rather than holding the weight handles 5 of the second member. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP § 2143.01. Without holding the weight handles, the user would be unable to exert a “substantial force” on the weight 4 into the weight stop 3 by sliding the weight back and forth in a reciprocating motion.

Because (1) Schmidt expressly teaches away from holding the “first member,” (2) Schmidt does not provide sufficient room for a person to hold the first member during operation, and (3) holding the first member of Schmidt would undermine the functionality of Schmidt, a user would have no reason to hold the first member during use of the Schmidt apparatus. Without any reason to hold the first member, it would not be obvious to put a hand guard on the first member. The rejection over Schmidt is improper. Reconsideration is requested.

Claim 6 is further rejected as being unpatentable under section 103(a) over Mitchell in view of Rutledge. The Office Action asserts that “Regarding the ‘hand guard’ and handle recitations, it would have been obvious to one having ordinary skill in the art at the time the invention was made to connect a hand guard to the first member of Mitchell, since the

Examiner takes Official Notice that the use of handles and hand guards are common and well known in hand-held firefighting piercing nozzles in order for a firefighter to safely grasp and swing the device at a target, while providing protection for the firefighter's hands when the device is being used." (Office Action, 11/30/2004, p. 15) This rejection is respectfully traversed.

The rejection under Mitchell is improper for the same reasons as the rejection under Schmidt. While it may be obvious to place a hand guard on an apparatus where the use grasps the apparatus, nothing in Mitchell teaches or suggests that the Mitchell apparatus be grasped by the "first member" to which the hand guard is attached, as recited in claim 6. The Office Action characterizes the tubular members 22, 24, 26 of Mitchell as being equivalent to the "second member" recited in claim 1 (from which claim 6 depends) and characterizes the "inlet port" 40 as being equivalent to the "first member" recited in claim 1. As with Schmidt, the Mitchell device is designed to be used as a bayonet, held by the second member rather than the first member. In fact, the "first member" of Mitchell is merely an "inlet port 40" for receiving liquid into the tubular members 22, 24, 26 that compose the "second member." Nothing in Mitchell teaches or suggests that the "first member" (the inlet port 40), rather than the "second member" (formed from the tubular members 22, 24, 26), is to be "safely grasp[ed]" or used to "swing the device at a target" as the Office Action suggests. Because there is no reason to hold the inlet member 40 during use, there is no motivation to add a handle guard to the inlet port 40, as recited in claim 6. Reconsideration is requested.

As originally filed, claim 6 should be allowable. Claim 6 has been rewritten in independent form, including the limitations of the claim from which it depended. As rewritten, independent claim 6 is now allowable.

Claim 25 is amended to recite that the first member is longer than the second member, such that the shape of the apparatus is more similar to that of an axe rather than that of a bayonet. The cited references each disclose a bayonet-style apparatus in which the second member (the member having "a plurality of holes") is longer than the first member (the member comprising "a hose connector"). As amended, claim 25 is allowable for the reasons discussed with respect to amended claim 1. Claims 26-30 depend from claim 25 and for these reasons and the other limitations they recite are also allowable. Reconsideration is requested.

Claims 14-15 and 31 are hereby canceled without prejudice or disclaimer.

Claim 32 has been amended to recite that the apparatus further includes a means for gripping the apparatus comprising a ridge running along the means for communicating. The cited references do not teach a grip that includes a ridge running along tubes. In the present invention, the ridge allows the user to control the orientation of the second member by preventing the first member from twisting the user's hand. Such a grip would not assist users of the bayonet-style devices of Mitchell or Schmidt because twisting of the bayonet-style devices would not change the orientation of the piercing tip relative to the target wall. Accordingly, it would not be obvious to add a grip with a ridge to the cited references. As amended, claim 32 is allowable. Claim 33 depends from claim 32 and for this reasons and the other limitations it recites is also allowable. Reconsideration is requested.

Claims 34-37 are added to more particularly claim the invention.

Specification

The specification is objected to for using inconsistent numbering for the first and second ends 62, 64 of the anvil 60. Two paragraphs of the specification are amended to more clearly describe the anvil 60. As amended, the specification overcomes the objections. Reconsideration is requested.

Drawings

The drawings are objected to for three (3) reasons: (1) the reference numeral height is too small; (2) the reference numeral "66" appears inconsistently; and (3) claimed elements are missing from the drawings, namely (a) the embodiment having a "single piece of tubing" as originally claimed, (b) the piercing tip having a detachable portion, and (c) embodiment showing the hose connection connected to the second member.

Replacement drawing sheets 1-7 are attached hereto. The replacement drawings, together with claim amendments, overcome these objections. The replacement drawings (1) include reference numerals with appropriate sizes, and (2) delete the numeral "66" in Figures 1 and 3. With respect to the third objection, the claims are amended to delete dependent claims related to objections (3)(a) and (3)(c) as identified above. Respectfully, with the

drawings as originally filed and the replacement drawings now filed show the detachable tip embodiment in Figures 4 and 6.

Conclusion

In view of the above amendments and remarks, Applicant respectfully asserts that the application is in condition for allowance. The above amendments add two (2) independent claims and add one (1) dependent claim, thereby generating additional claims fees of \$225 (2 x \$100 + 1 x \$25). Additionally, this reply is filed within one (1) month of the three-month response period, thereby generating an extension fee of \$60. A petition for extension is filed herewith. A check in the amount of \$285 is enclosed herewith. If any additional fees are necessary, the Office is hereby authorized to charge any fee deficiency associated with this communication to Deposit Account 04-1420. Prompt reexamination and allowance of claims 1-13, 16-30, and 32-37 is respectfully requested.

Respectfully submitted,

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